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REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicant respectfully submits that the pending claims are not anticipated under 35 U.S.C. § 102(e) and are not rendered obvious under 35 U.S.C. § 103(a). Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicant respectfully requests that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicant will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 102

Claims 1-4, 7-11, 13-21 and 48-52, 54-58 and 60-64 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,850,271 ("the Ichikawa patent"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner maintains that the Ichikawa patent discloses "selecting a predetermined piece of image forming instruction information from among the plurality of pieces of image forming instruction information stored in said storing unit, based on the image capturing

condition set by said setting unit" as recited in the claimed invention. (Paper No. 20060831, page 4)

In the portion of the Ichikawa patent cited by the Examiner, each correction amount (63B1, 62B2, 63B3, 63B4, 63B5) is read from print information 63B in image file 63 recorded in smart media 30, on the basis of the setting (automatic re-learning) by mode dial 84. However, in the present invention, in selecting image forming instruction information on the basis of image capturing condition, the "capturing condition" (or shooting mode or shooting condition) is **the one in which the subject was actually captured**. The Ichikawa patent does not disclose this feature.

As is understood by one skilled in the art in light of the specification, the "capturing condition" (or shooting mode, or shooting condition) **affects how** (i.e., the capture conditions under which) the subject image is captured. On the other hand, even under the Examiner's interpretation of the Ichikawa patent, the mode set by dial 84 (See, e.g., FIG. 5A and column 5, lines 16-32.) **affects print correction, not how** (i.e., the capture conditions under which) **the subject image is to be** (or was) **captured**. Also, since the capturing condition is the one in which the subject was actually captured, the image forming instruction information is not selected before a shooting. Instead, in the Ichikawa patent, each correction amount (63B1, 62B2, 63B3, 63B4, 63B5) is read from print information 63B before shooting.

In order to clarify the above described difference between present invention and the Ichikawa patent, each of independent claims 1-4, 7, 8, 10, 11, 13 and 14 have been amended to recite selecting a predetermined piece of

image forming instruction information from among a plurality of pieces of image forming instruction information stored in a storing unit, based on an image capturing condition set by said setting unit, **where the image capturing condition is the image capturing condition under which the subject was captured.**

Independent claims 9, 17, 20 and 21 have also been amended to highlight this difference, where the shooting mode or shooting condition is that under which the subject was captured.

Accordingly, independent claims 1-4, 7-11, 13, 14, 17, 20 and 21 are not anticipated by the Ichikawa patent for at least this reason. Since claims 15, 16, 18, 19, 48-52, 54-58 and 60-64 depend, either directly or indirectly from one of these independent claims, these claims are similarly not anticipated by the Ichikawa patent.

Rejections under 35 U.S.C. § 103

Claims 5, 6, 12, 53 and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ichikawa patent in view of U.S. Patent No. 6,965,410 B1 ("the Yamagishi patent"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claims 5 and 12 have been amended to recite selecting a predetermined piece of image forming instruction information from among a plurality of pieces of image forming instruction information stored in a storing unit, based on an image capturing condition set by said setting unit, **where the image capturing condition**

is the image capturing condition under which the subject was captured.

The Examiner contends that the Yamagishi patent teaches assigning priorities to image capturing conditions and selecting pieces of information based on the assigned priorities. Even assuming, *arguendo*, that the Yamagishi patent includes such a teaching, and further assuming, *arguendo*, that one skilled in the art would have been motivated to combine these patents as proposed by the Examiner, independent claims 5 and 12 would not be rendered obvious by these patents for at least the reasons discussed above in the rejection under section 102.

Accordingly, independent claims 5 and 12 are not rendered obvious by the Ichikawa and Yamagishi patents for at least the foregoing reason. Since claims 6 and 53 depend from claim 5, and since claim 59 depends from claim 12, these claims are similarly not rendered obvious by these patents.

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Conclusion

In view of the foregoing amendments and remarks, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicant requests that the Examiner pass this application to issue.

Respectfully submitted,

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